

- II. Claim 34, drawn to a method of producing an additive carbon black having a particular surface area with particular amines and its use in a polymer, classified in class 423, subclass 449.2+.
- III. Claims 35-55 and 71-76, drawn to a method of combining a polymer and a carbon black of Group I, classified in class 524 and 152, subclass 495+ and 151+, respectively.
- IV. Claims 56-68, drawn to a method of combining a polymer and a carbon black treated with particular amines, classified in class 523, subclass 215+ and 351+.”

Applicants provisionally elect Group I, Claims 1-33, 69 and 70. Applicants request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all the claims. M.P.E.P § 803 provides:

If the search and examination of an application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (Emphasis added.)

Thus, for a restriction to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden. See M.P.E.P § 803.

The Examiner has not shown that the second requirement has been met. Specifically, the Examiner has not shown that it would be a serious burden to search and examine all of the groups together. At a minimum, Group II should be examined with Group I because the Group II claim is classified in the exact same class and subclass. Thus, there would not be a

burdensome search to at least search the Group II claim as well. Consequently, reconsideration and modification or withdrawal of the restriction is requested.

A Supplemental Information Disclosure Statement is being filed concurrently herewith.

Applicants await an action on the merits.

The Commissioner is hereby authorized to charge any fees which may be required to
Deposit Account No. 14-0629.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this document and any documents referenced herein as being enclosed herein is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.



Mitchell A. Katz

Date April 2, 2004